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EXAMINER	
COLBERT, ELLA	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GE, LI, MICHAEL D. MCCART, CHARLES H. ROSA, AVNER SCHNEUR, and RINA ROTSHILD SCHNEUR

Appeal 2010-002410
Application 09/664,226
Technology Center 3600

Before: MURRIEL E. CRAWFORD, HUBERT C. LORIN, and BIBHU R. MOHANTY, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1-52. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6 (2002).

The claimed invention is generally directed to systems and methods for determining an optimal award schedule for at least partial satisfaction of a requisition including receiving from a buyer over a computer network, public buyer constraints representative of the requisition. These public buyer constraints are made available to prospective suppliers over the computer network. Candidate suppliers from the set of prospective suppliers then submit bids for analysis by the buyer. This is followed by the determination of an optimal award schedule for at least partial satisfaction of the buyer's requisition (Spec. Abstr.). Claim 1, reproduced below, is further illustrative of the claimed subject matter.

> 1. A computer-implemented method for determining an optimal award schedule for at least partial satisfaction of a requisition, said method comprising:
>
> receiving from a buyer, over a computer network, public buyer constraints representative of said requisition;
>
> receiving from the buyer, over said computer network, a objective function including non-price criteria;
>
> transmitting to a set of suppliers, over said computer network, said public buyer constraints;
>
> receiving from each supplier, over said computer network, a bid responsive to said public buyer constraints; and
>
> utilizing, by a programmed computer, the objective function to select a subset of suppliers and determine an optimal award schedule for at least partial satisfaction of said requisition utilizing the selected suppliers,
>
> wherein said optimal award schedule includes information indicative of the manner in which each of said selected subset of suppliers is to at least partially satisfy said requisition.

Claims 1 and 27 stand rejected under 35 U.S.C. § 112, second paragraph, for insufficient antecedent basis; claims 1-15 and 27-41 stand rejected under 35 U.S.C. § 102(b) as anticipated by Shkedy (US Pat. 6,260,024 B1, iss. Jul. 10, 2001); and claims 16-26 and 42-52 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Shkedy in view of Carlton-Foss[2] (US Pat. 6,647,373 B1, iss. Nov. 11, 2003).

We AFFIRM-IN-PART.

ISSUES

Did the Examiner err in asserting that various recitations of "suppliers" in independent claims 1 and 27 lack antecedent basis, and thus do not meet the definiteness requirements of 35 U.S.C. § 112, second paragraph?

Did the Examiner err in asserting that Shkedy discloses "utilizing… the objective function to select a subset of suppliers and determine an optimal award schedule for at least partial satisfaction of said requisition utilizing the selected suppliers," as recited in independent claims 1 and 27?

FINDINGS OF FACT

We adopt the Examiner's findings of fact, as set forth in the last paragraph on page 15 of the Examiner's Answer.

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[2] The objections to the drawings (App. Br. 5; Exam'r's Ans. 4-5) are directed to petitionable rather than appealable matter. *See Manual of Patent Examining Procedure* (MPEP) § 1002 and 1201 (8th Ed., Rev. 8, Jul. 2010). Accordingly, we will not review these issues.

ANALYSIS

Antecedent Basis

We are partially persuaded that the Examiner erred in asserting that aspects of independent claims 1 and 27 lack antecedent basis, and thus do not meet the definiteness requirements of 35 U.S.C. § 112, second paragraph (App. Br. 4-5). We agree with the Examiner that "subset of suppliers," as recited in lines 11-12 of independent claim 1, is indefinite, because it is unclear what "set" the "subset" is taken from (Exam'r's Ans. 4, 14-15). We assume Appellants mean for the "subset" to be taken from the "set" recited in line 7. However, because other scenarios are possible where the "set" and "subset" are unrelated, and thus it is unclear whether the "set" and "subset" are indeed related to each other, we will sustain this aspect of the rejection.

For "the selected suppliers," and "said selected subset of suppliers," however, which are respectively recited in lines 13 and 15 of independent claim 1, it is reasonably clear that the aforementioned "subset of suppliers" in lines 11-12 serve as a proper antecedent basis for both aspects. While we agree with the Examiner that Appellants should have used more consistent language to avoid confusion, when the claim is read as a whole, these terms are not indefinite for lacking antecedent basis. Accordingly, we do not sustain these aspects of the rejection of independent claim 1.

The aforementioned reasoning also applies to the corresponding portions of independent claim 27.

Prior Art Rejections

We are not persuaded that the Examiner erred in asserting that Shkedy discloses "utilizing… the objective function to select a subset of suppliers

and determine an optimal award schedule for at least partial satisfaction of said requisition utilizing the selected suppliers," as recited in independent claims 1 and 27 (App. Br. 5-8; Reply Br. 4-6). Appellants assert that the "*Shkedy* system cannot create an 'optimal award schedule' that allows multiple sellers to satisfy a buyer's requisition in an optimal fashion because a single buyer always wins the entire award" (App. Br. 7; emphasis original). However, independent claims 1 and 27 recite a "subset of suppliers," which could be only one supplier under a broadest reasonable construction. *See In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) ("[d]uring examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art").

Appellants also assert that "*Shkedy* cannot satisfy the requirements of the present claims that require an 'objective function' including 'non-price criteria' to create an optimal award schedule that is optimal with respect to both price and non-price criteria," because "non-price requirements do no more than exclude a non-conforming bidder from consideration" (App. Br. 7; Reply Br. 4). However, the exclusion of non-conforming bidders merely means that the optimal award schedule treats the non-price criteria in a binary manner. While Appellants may mean for the optimization engine that creates the optimal award schedule to treat the price and non-price criteria in a more nuanced way by weighting each criteria in a non-binary manner, such an aspect is not set forth in the claims. *See CollegeNet, Inc. v.*

ApplyYourself, Inc., 418 F.3d 1225, 1231 (Fed. Cir. 2005) (while the specification can be examined for proper context of a claim term, limitations from the specification will not be imported into the claims).

Appellants further assert that Shkedy does not disclose "an optimal award schedule that 'includes information indicative of the manner in which each of said selected subset of suppliers is to at least partially satisfy said requisition'" (App. Br. 8). By using the terms "at least partially satisfy said requisition," Shkedy's disclosure of a single supplier that fully satisfies the requisition does "at least partially satisfy" the requisition, as recited in independent claims 1 and 27.

Accordingly, we sustain the prior art rejections of independent claims 1 and 27. As Appellants do not separately argue the rejections of dependent claims 2-26 and 28-52 (App. Br. 8), we sustain the rejections of those claims as well.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1) (2007).

AFFIRMED-IN-PART

hh

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